

discussed in that conversation in response to the Examiner's request in a subsequent telephone interview on November 4, 2002 with regard to the Final Office Action mailed by the Examiner on 24 September 2002.

The Final Office Action rejects claims 1 - 20 under 35 U.S.C. 103(a) as being unpatentable over Suess, et al., U. S. 5,985,078 in view of Abrams, U.S. 5,908,527. Applicants respectfully request that the Examiner reconsider allowance of claims 1-20 with regard to the rejection based upon "metallic embossing foil" advanced by the Examiner on pages 2 and 3 of the first Office Action and repeated verbatim on pages 2 and 3 of the Final Office Action. [Applicants do not claim a "metallic embossing foil" in any of the independent claims 1, 11 or 20 but only refer to the term "metallic" in dependent claims 16 and 19, pending from independent claim 11, wherein the "metallic" coating on a transfer sheet is applied to an already embossed wrapping film to create Applicants' novel laminated embossed wrapping film of claim 11.] In other words, in claims 16 and 19, Applicants apply, by hot transfer, the metallic coating from a hot transfer foil onto an embossed (raised) surface of a wrapping film and remove the carrier, as well as the portion of coating not transferred, thus creating the novel laminated embossed wrapping film. Thus, Applicants believe that the rejection of claims 1 - 20 based on use of the terms "metallic embossing foil" is improper and respectfully request reconsideration and allowance of claims 1 - 20. If the Examiner persists in this rejection, Applicants also respectfully request the Examiner's assistance with language acceptable to the Examiner to render these claims allowable.

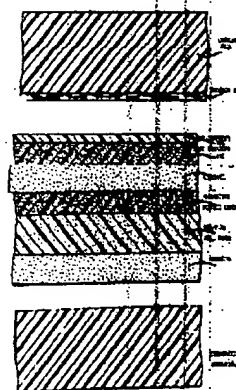
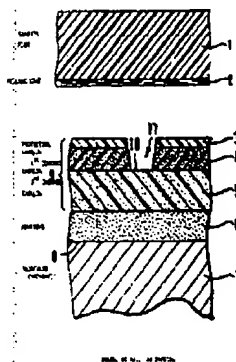
In all other claims, Applicants apply, by hot transfer, coating from at least one hot transfer foil onto a planar wrapping film and thereafter remove the carrier thus creating the novel laminated wrapping films recited in claims 1 - 15, 17, 18 and 20. Suess, et al., admit that the material of Fig. 1 is readily available and the ink thereon is transferred by means of a normal transfer operation to the surface of the machine and thereafter be laser etched through the outer protective layer and the first lacquer layer. Thus, as Applicants assert in Amendment A filed on 08 July 2002, Suess, et al., is merely describing the known processes of applying the ink, paint or lacquer layers to the polyester backing carrier including the adhesive layer. The Examiner's attention is drawn to column 3 in lines 4 - 7 wherein Suess, et al., describe the "normal" transfer

operation and in column 5 in lines 9 - 10 wherein Suess, et al., describe Fig 1 as a partial view in section through a hot embossing foil for use in a **method of the invention**. Thus, in claims 16 and 19, Applicants use the same commercially available hot transfer foil used by Suess, et al., to create the novel laminated wrapping films. Suess, et al., also admit that the hot embossing foil is applied as "...layers of lacquer in an only region-wise manner to a flexible carrier such as a plastic foil or **metal strip**, for example by means of a printing process." In printing processes known long before the time of Suess, et al., it was common to print "region-wise" by using a printing roller having raised portions (that is, an embossing roller) which only printed on the carrier where the raised portions of the roller applied heat and/or pressure to the carrier. It is clear through a careful review of the independent claim of Suess, et al., that the entire disclosure of Suess, et al., is directed to the **method** of marking a surface and not the material applied to the surface. Thus, Suess, et al., are applying the entire structure of Fig. 1 to the surface to be marked and thereafter laser etching the outer layer of lacquer and the protective layer. Applicants prepared drawings using the cross-sectional structures as shown in Abrams, Nelson and Suess, et al., to try to understand the Examiner's rejections advanced in the first Office Action, these drawings clearly showing that the references do not teach Applicants' disclosure.

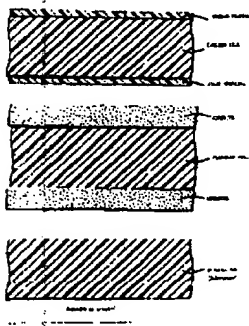
Referring now to the drawing on the left labeled "Suess, et al., as recited" that was faxed to the Examiner on October 28, 2002, the lacquers are adhered to the machine substrate and the carrier is removed from the protective layer. The protective lacquer layer and the 1st colored lacquer layer are then etched "region-wise" at numeral 11.

Contrasting this structure to the drawing labeled "Applicants' disclosure" appearing on the right, the Examiner will readily observe that

Applicants begin with a wrapping film (paper), apply an adhesive to one side of the paper, apply a decorative surface to the side of the wrapping paper opposite the side having the adhesive



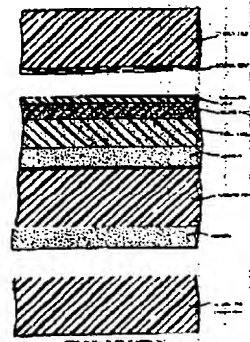
thereon, apply at least one additional adhesive and hot transfer ink to the decorative surface by removing the adhesive and hot transfer ink from a carrier in a hot transfer process, wherein each of the layers of hot transfer ink has the carrier removed therefrom. The final laminated decorative wrapping film is wound upon a spindle to create a roll of decorative material for subsequent application to a substrate. The Examiner will surely appreciate that Applicants retain the flexible wrapping paper with the decorative material applied thereto whereas Suess, et al., do not. The Examiner will further appreciate that the commercially available material used by Suess, et al., could as easily be used by Applicants to apply same to another decorative surface. Thus, it is not the commercially available hot transfer material that Applicants seek to obtain a letters patent upon but rather the laminated wrapping material made by marrying at least two decorative materials together as shown in the drawing labeled "Applicants' disclosure" and in Figs. 3, 4, 6, 8 and 9 in the original specification wherein the wrapping film has been shown as applied to a piece of molding. Thus, Applicants believe that the rejection of claims 1 - 20 based on use of the terms "metallic" combined with "embossing foil" is improper and respectfully request reconsideration and allowance of claims 1 - 20.



Additionally, referring to Abrams showing of a printed foil laminate, as is evident in the drawing labeled Abrams, as recited, appearing here at the left, in contrast to Suess, et al., and Applicants' disclosure, both shown above, Abrams retains an aluminum foil sheet and a top layer of thermoplastic, specifically polyester, with the printing applied on both sides of the polyester sheet. This entire structure is then applied to a polypropylene contact lens case with an adhesive previously applied to the bottom side of the aluminum foil sheet. The

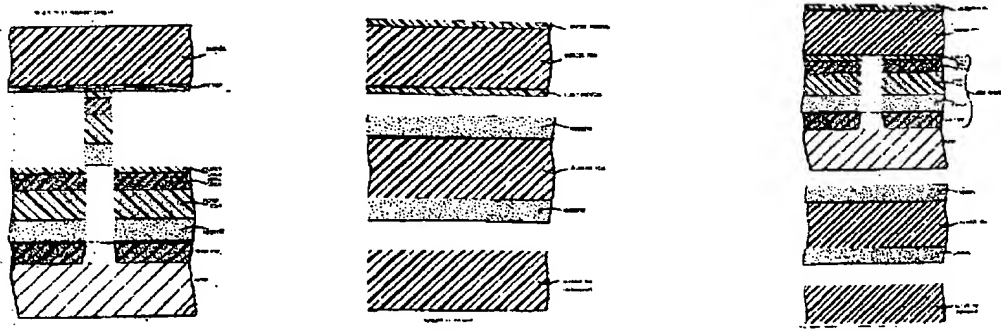
Examiner's attention is drawn to column 2 at lines 51 - 57 wherein Abrams admits receiving the "...foil laminate...as a continuous sheet or web from a suitable supply roll or the like..."

Referring now to the drawing at the right labeled Suess, et al., in view of Abrams, '527, the structure of Suess, et al., (the protective layer, first and second lacquers and the adhesive) are shown laminated to the



aluminum foil according to Abrams with the carrier of Suess, et al., removed. This entire structure is then applied to the blister pack as recited in Abrams in column 1 at line 20 which is identical to the contact lens case of Abrams, et al. The Examiner correctly states that Abrams and Suess, et al., are analogous art but it should be abundantly clear that as they are different from each other, each is also different from Applicants' disclosure. Therefore, as Suess, et al., do not teach Applicants' disclosure, and Abrams does not teach Applicants' disclosure, the combination with Abrams, '527, also does not teach Applicants' disclosure. Thus, Applicants believe that the rejection of claims 1 - 20 based on use of the terms "metallic" combined with "embossing foil" shows only the recited reference of Abrams and therefore respectfully request reconsideration and allowance of claims 1 - 20. If the Examiner persists in this rejection, Applicants also respectfully request the Examiner's assistance with language acceptable to the Examiner to render these claims allowable.

The Final Office Action rejects claims 1 - 10 under 35U.S.C.103(a) as being unpatentable over Abrams, U.S. 5,653,844 in view of Nelson, U. S. 4,724,026. Applicants present here the additional drawings prepared by Applicants for the purpose of establishing visual reference for the Examiner's rejections in the first Office Action similarly show how Applicants' disclosure differs from Nelson and Abrams in view of Nelson. On the left is Nelson just after removal of the carrier and the portion of colored layer, the metal layer, primer coat, adhesive and print coat, in the middle is Abrams, as recited and at the right is Abrams in view of Nelson with Nelson as the first printing.



Discarding the carrier, release and wedge of Nelson and applying the remainder as the first printing in Abrams as shown with the brackets yields Abrams in view of Nelson. Clearly, this is different from Applicants' disclosure and Applicants believe that the combination does not teach Applicants' disclosure and therefore respectfully request reconsideration and allowance of Applicants' claims presented in Amendment A. For further proof that none of the combinations suggested by the Examiner teach Applicants' disclosure, the Examiner is invited to lay each of the other specific drawings in turn alongside Applicants' disclosure to readily determine the differences. Applicants respectfully request reconsideration and allowance of claims 1 - 10. However, if the Examiner persists in this rejection, Applicants also respectfully request the Examiner's assistance with language acceptable to the Examiner to render these claims allowable.

The Final Office Action states in paragraph 7 that Applicants' arguments to the rejections of the claims based on 35USC103(a) are not persuasive. Applicants respectfully request that the Examiner reconsider allowance of claims 1-20 with regard to the rejection based upon the adjective "rolling" and its transitive verb root "roll" as equated with the noun "roll." Applicants do not claim the process of "rolling" onto a surface but rather claim a "roll" of decorative wrapping film to be used in a later process of wrapping a substrate. As with "foil" or "film" or "embossing," "roll" has multiple meanings and it is the noun "roll" used in Applicants' claims to indicate a package of material prepared for sale, not the process of rolling a lacquer layer onto a machine face as in Suess, et al. Applicants respectfully request the reconsideration of claims 1 - 20 with regard to the noun roll.

Further in paragraph 7, the Final Office Action states that the intended use of the product claimed by Applicants carries little weight in determining the patentability of the claims. Applicants respectfully request that the Examiner reconsider allowance of claims 1-20 with regard to the rejection based upon specific use references "trim pieces" and "frame elements" as having little patentable weight advanced by the Examiner on pages 2 and 3 of the first Office Action and repeated verbatim on pages 2 and 3 of the Final Office Action. In Amendment A, Applicants removed the specific use references from all of the claims thus overcoming the Examiner's rejections in reference to the intended use having little patentable weight.

Therefore, Applicants respectfully request reconsideration and allowance of claims 1 - 20.

Additionally, in paragraph 7 of the Final Office action, the Examiner says that Applicants interpret the embossing of Suess, et al., as a common practice of transferring an ink or lacquer to a machine face and therefore the Examiner disagrees that the use of the Abstract language is a broadening of the disclosure of Suess, et al.,. As stated above and as is clear from the drawings gathered directly from Suess, et al., Suess, et al., is, in fact, merely applying an ink or lacquer to a machine face and thereafter etching the outer layer thereof and the only mention of "embossing" is in the abstract of Suess, et al., and then only in the reference to the commonly known embossing foils readily available from a variety of manufacturers. Therefore Applicants respectfully request that the Examiner reconsider allowance of claims 1-20 with regard to the rejection based upon the use of the abstract of Suess, et al., and Abrams as broadening the scope of the claims of these patents. In accordance with 37CFR1.72, use of the abstract for interpreting the scope of the claims is not proper. Applicants maintain that combining the metal substrate of Suess, et al., from column 2, line 53 or column 3, line 17 with the embossing foil cited in the abstract is improper broadening of the disclosure of Suess, et al. Applicants further maintain that combining the purchased foil laminate, cited in column 2 on line 14 of Abrams with the method of double side printing in the abstract is improper broadening of the disclosure of Abrams. Therefore, Applicants respectfully request reconsideration and allowance of claims 1 - 20.

Applicants believe claims 1 - 20 are allowable over Suess, et al., Abrams, Nelson and any combination of these three references and with any other known prior art reference as no combination suggests a decorative molding wrapping film for decorating a molding comprising at least one hot transfer inked foil carried on a carrier laminated onto a planar wrapping film thereby creating a novel decorative molding wrapping film wherein the carrier is removed from the decorative molding wrapping film. However, if the Examiner persists with the rejections based upon Suess, et al., in view of Abrams, or Abrams in view of Nelson, Applicants respectfully request the Examiner's assistance in restructuring the claims to put these claims in condition for allowance.

In Amendment A, timely filed on 08 July 2002, Applicants amended claims 1 - 10 to

overcome the Examiner's rejection of claims 1 -10 based on 35U.S.C.112, second paragraph, further amended claims 1, 2, 11, 12 and 20 to remove the specific use language, amended claims 1 - 20 to change the word "foil" to "film" when referring to the decorative wrapping film, provided traverse of the rejection of claims 1 - 20 based upon 35 U.S.C. 103(a) and further provided traverse of the additional rejection of claims 1 - 10 based upon 35 U.S.C.103(a) thereby placing this application in condition for allowance. Thus, claims 1 - 20 remain in this application and Applicants respectfully request allowance thereof.

In view of the above, an Action on the merits of this application, as amended, and an allowance thereof is respectfully requested.

Respectfully submitted,

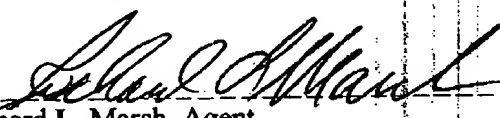
Herbert M. Straub,

Martin D. Straub and

Timothy D. Ryan

Joint Inventors

Date: 23 December 2002
Phone: (417) 887-8441
(417) 887-3731 (home)
Fax: (417) 887-8441
E-mail: richmarsh@focusonpatents.com

By 
Richard L. Marsh, Agent
Registration No. 31,637
4116 E. Latoka
Springfield, Missouri 65809